

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in a prior Office Action.

Election/Restrictions

2. Applicant's election without traverse of Group II, claims 5-10, in the reply filed on 7 July 2009 is acknowledged.
3. Claims 1-4 and claims 11-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7 July 2009.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because it includes phrases that can be implied (*"is described."*). Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

6. The submitted German reference DE 3331016 has been considered in light of the submitted document and translation.

Double Patenting

7. Claims 5-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,179,529 in view of USPA 2003/0118970 to Rusin et al.

8. The rejections of claims 5-10 set forth in the office action mailed 9 January 2009 are hereby incorporated by reference and reapplied.

9. Claims 5-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,910,667 in view of USPA 2003/0118970 to Rusin et al.

10. The rejections of claims 5-10 set forth in the office action mailed 9 January 2009 are hereby incorporated by reference and reapplied.

11. Claims 5-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-28 of copending

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Application No. 11/721,551. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious with respect to one another.

12. Instant claim 5 has been amended to recite "the pressure sensitive adhesive composition comprising a styrene-based block copolymer and a basic component."

There is no longer the recitation of the "cohesive component." However, it would have been obvious to one of ordinary skill in the art that the specific cohesive component comprising a styrene-based block copolymer would meet the broad disclosure of styrene-based block copolymer as presently claimed and thereby one of ordinary skill in the art would have arrived at the present invention from the copending one.

13. Instant claims 5-7 are now obvious over claims 24-26 of the '551 application.

The claims are not identical because amended claim 5 no longer recites the "cohesive component."

14. Instant claims 8 and 9 are obvious over claims 27 and 28 of the '551 application.

Although their wording is similar, the limitations are not identical because of their differing dependencies. They are obvious because simply changing the dependencies of the '551 application can yield instant claims 8 and 9.

Claim Rejections - 35 USC § 102

15. Claims 5-10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPA 2003/0118970 to Rusin et al.

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16. Regarding claim 5, Rusin et al. teaches a pressure sensitive adhesive tape (*page 6, para. [0060]*) comprising a substrate (*backing*) with an adhesive coating. The pressure sensitive adhesive layer is provided on at least one surface of said substrate, because it can be coated directly onto the substrate or formed as a separate layer and then laminated (*page 6, para. [0060]*). Both the substrate (*page 6, para. [0055]*) and the adhesive (*page 4, para. [0040]*) are capable of being stretched (*extensible, page 3, para. [0032]*). Rusin et al. also teaches that the pressure sensitive adhesive may include a multitude of compositions such as styrene-based block copolymers and basic components such as (meth)acrylic copolymers (*page 3, para. [0034]*), and that the different listed pressure sensitive adhesive compositions may be combined (*page 4, para. [0040]*).

17. Regarding claim 6, Rusin et al. teaches the pressure sensitive adhesive tape as above, and that it comprises a highly extensible polymer sheet material, such that it exhibits a lengthwise elongation at break of about 150% or greater (*page 6, para. [0055]*). It is noted that Applicant requires "highly extensible" tapes to be able to elongate at least about 150% (*page 13, lines 7-11*). Furthermore, Rusin et al. teaches that the films (*backings*) may be single- or multi-layer, and that the films are polymeric (*page 6, para. 0058*).

18. Regarding claim 7, Rusin et al. teaches a pressure sensitive adhesive tape as above, and that the highly extensible polymer film has lengthwise elongation at break of about 50% or greater, and less than about 1200% (*page 6, para. [0055]*). The same highly extensible polymer films also have a Young's modulus between 6894.7 kPa and

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499,865.8 kPa (*page 6, para. [0056], at least about 689 KPa, less than about 499,870 KPa, overlaps the claimed range*). The films may also be foamed (*page 6, para. [0058]*).

19. Regarding claim 8, Rusin et al. teaches a pressure sensitive adhesive tape as above, and that the backing film may be a polymeric foam film (*page 6, para. [0058]*). Rusin et al.'s backing film may also be multilayer films, comprised of combinations of non-wovens, porous films, and foam-like films (*page 6, para. [0058]*). The foam-like films of Rusin et al. are the same as foamed films, and non-woven and porous films are examples of foam-free films. Rusin et al. thus teaches that the substrate may be a composite, multilayer film of foamed and foaming-free film.

20. Regarding claim 9, Rusin et al. teaches a pressure sensitive adhesive tape as above, and further teaches that the pressure sensitive adhesive layer may have a thickness of 25 to 1,000 micrometers (*page 4, para. 0040*). This overlaps Applicant's claimed range.

21. Regarding claim 10, Rusin et al. teaches a pressure sensitive adhesive tape as above, and additionally teaches that a release liner may cover the pressure sensitive adhesive (*page 7, para. 0068*).

22. Regarding claim 15, Rusin et al. teaches a pressure sensitive adhesive tape as above, and that the highly extensible polymer film has elongation at break of about 50% or greater, and less than about 1200% (*page 6, para. [0055]*) when stretched in a lengthwise direction.

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23. Regarding claim 16, Rusin teaches a basic copolymer comprising a copolymer of an alkyl (meth)acrylate (*paragraph [0034]*) and a nitrogen-containing vinyl monomer (*paragraph [0037]*) such as N-vinyl pyrrolidone (*paragraph [0037]*). In light of the use of N-vinyl pyrrolidone, a nitrogen-containing vinyl monomer, the polymer would be considered a basic component.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

26. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

27. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPA 2003/0118970 to Rusin et al. in view of USPN 6,608,143 to Fukuoka et al.

28. Regarding claims 16-18, Rusin teaches the pressure sensitive adhesive tape of claim 5 as outlined above. Rusin is silent with respect to the basic component comprising a copolymer of an alkyl (meth)acrylate and a nitrogen-containing vinyl monomer.

29. Fukuoka teaches that in a pressure sensitive adhesive, the (meth)acrylic component may be a copolymer of an alkyl (meth)acrylate and a nitrogen-containing vinyl monomer such as 2- or 4-vinylpyridine (*column 3, lines 49-61 and column 6, line 7*) (*claims 16-17*).

30. Fukuoka also teaches that the copolymer of an alkyl (meth)acrylate and a nitrogen-containing vinyl monomer is grafted (*column 3, line 50*) with a polystyrene (*polymer (e), column 7, lines 43-62*). The polystyrene has a glass transition point of at least 30°C, which overlaps the claimed range of 20 to 250°C, and a number average molecular weight of 2,000-30,000, which overlaps the claimed weight average molecular weight of 2,000 to 500,000 (*claim 18*). Note that although Fukuoka only discloses the number average molecular weight, but since the PolyDispersity Index of any polymer is always at least unity, and $PDI = Mw/Mn$, it is clear that the compound of Fukuoka must overlap applicant's range.

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31. Fukuoka teaches that for acrylic pressure sensitive adhesives, past attempts at using acrylic monomers have been met with difficulty, owing to the polar nature of the acrylic monomers themselves (*column 1, lines 65-67*), despite their many desirable properties (*column 1, lines 55-58*). Fukuoka thus suggests that an acrylic copolymer be provided which contains polymeric portions having different polarities and glass transition temperatures, in order to permit broader design freedom, and thus greater product applicability (*column 3, lines 15-21*). Fukuoka also discusses that the resulting copolymers result in good adherent properties, properly-reconciled removability, and adherend non-staining properties (*column 2, lines 28-34*).

32. It would have therefore been obvious to one of ordinary skill in the art at the time of invention to use a graft copolymer of the alkyl (meth)acrylate and nitrogen-containing vinyl monomer with a polystyrene having the presently claimed glass transition temperature and molecular weight range.

Response to Arguments

33. Receipt of the response to the previous Office Action, dated 7 July 2009, is acknowledged.

34. The objection to the abstract is withdrawn in light of the newly submitted abstract. However, a new objection has been raised to the new abstract.

35. The objection to the drawings is withdrawn in light of the amendments to the specification.

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36. In regards to the double patenting claims, applicant affirms that claims 5-10 were rejected on grounds of nonstatutory obviousness-type double patenting over Mizuno in view of Rusin. Additionally, claim 5 has been amended to recite "the pressure sensitive adhesive composition comprising a styrene-based block copolymer and a basic component." There is no longer the recitation of the "cohesive component" that is present in claim 1. This amendment does not mitigate the rejections over USPN 7,179,529 in view of Rusin and USPN 6,910,667 in view of Rusin. These rejections have been reapplied.

37. The amendment to the claims does alter the grounds of rejection over copending application 11/721,551, and these new grounds of rejection have been applied.

38. The rejection under 35 U.S.C. 112, second paragraph has been withdrawn in light of the amendments to the claims.

39. Applicant's arguments in response to the rejection under 35 U.S.C. 102(b) have been fully considered but they are not persuasive.

40. Applicant submits that Rusin does not teach any components, monomers, etc. that are basic, with "basic" being defined as chemical base, or a compound capable of being protonated with a hydrogen cation. However, it is clear that Rusin discloses using adhesive that comprises poly(meth)acrylates (*paragraph [0034]*) wherein Rusin further discloses that such polymers are derived from at least one alkyl ester monomer and comonomer such as N-vinyl pyrrolidone (*paragraph [0037]*). In light of the use of N-vinyl pyrrolidone, a nitrogen-containing vinyl monomer, the polymer would be considered a basic component.

Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS KOKKINOS whose telephone number is (571) 270-7384. The examiner can normally be reached on Monday-Thursday 9am-5pm.

44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NK/

15 October 2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794